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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,947	10/05/2005	Tooru Yamakita	05670/LH	3610
1933 7590 05/29/2008 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER				
MISLEH, JUSTIN P				
ART UNIT		PAPER NUMBER		
2622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,947

Applicant(s)

YAMAKITA, TOORU

Examiner

JUSTIN P. MISLEH

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on October 5, 2005; October 10, 2006, and December 11, 2005 are in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statements are being considered by the Examiner.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5. **Claims 8 and 9** are objected to because of the following informalities: subject matter omission.

6. **Claims 8 and 9** each require "a computer program product configured to store program instructions for execution on a computer system enabling the computer system to perform".

The Examiner notes the specification and drawings do not specify the exact "computer program product". Such omission results in the possibility of the claimed "computer program product" including non-statutory subject matter (e.g., carrier wave or modulated signal). The Examiner recommends either eliminating this claim language or amending the disclosure to specify exactly what types of computer program products are included under "computer program product". Applicant is reminded no new matter should be introduced.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 4, and 5 - 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Boles (US 2005/0103840 A1).

9. For **Claim 1 and 8**, Boles discloses, as shown in figures 1 and 2 and as stated in paragraphs 34 - 37, 40, and 42, an image pickup apparatus (computer 1) comprising:

an image capture device (11) which captures an image of an article (stone 12);

an electronic tag reader (6) which reads electronic tag information from an electronic tag (7); and

a writing device (6), when the image of the article is captured by the image capture device (11), which causes the electronic tag reader to read electronic tag information and writes

the image of the article captured by the image capture device into the electronic tag (See paragraphs 34 – 36. Boles states, "The resulting digitized images are output to an inductive writer 6 which is arranged to store the images in a memory 8 of a miniature RFID ... tag 7.").

10. For **Claims 4 and 9**, Boles discloses, as shown in figures 1, 2, and 4 and as stated in paragraphs 34 – 37, 40, 42, and 44, an image pickup apparatus (computer 1) comprising:

an image capture device (11) which captures an image of an article (stone 12);

an electronic tag reader (6) which reads electronic tag information from an electronic tag (7); and

a writing device (6) which relates the image of the article captured by the image capture device to the electronic tag information read by the electronic tag reader (6) and writes the related image and electronic tag information into a database (See paragraph 44. Boles states, "A communications link 5 links the computer with its hard drive to an archive retrieval system 140 (e.g. a server) which hosts an image and information database 110 ... this database includes fields for the identifier (# symbol 1 to # symbol n), images (I1, I2. . . In) and transactions (T1, T2 . . . Tn) such that inputting the identifier of a gem stone or other valuable enables the corresponding sets of images and transactions to be retrieved by computer 1.").

11. For **Claim 5**, Boles discloses, as shown in figures 1, 2, and 4 and as stated in paragraphs 34 – 37, 40, 42, and 44, an electronic tag reading apparatus comprising:

an electronic tag reader (6) which reads electronic tag information from an electronic tag (7); and

a display device (1) which displays an image corresponding to the electronic tag information read by the electronic tag reader (See paragraph 40. Boles states, "These previously

obtained electron micrographs are retrieved by computer I either directly from the associated RFID tag 7 using the reader/writer 6 or by accessing a remote archive 140 (FIG. 4--discussed in more detail below) using a communications link 5 ... [these] are displayed on the screen 3 and compared (e.g. visually) with electron micrographs acquired from corresponding view points from the gem stone 12 or other valuable as presented for evaluation.”).

12. As for **Claim 6**, Boles discloses, as stated in paragraph 40, wherein the display device (1), when the electronic tag information read by the electronic tag reader includes image data, displays an image based on the image data included in the electronic tag information (Boles specifically indicates, “[these] previously obtained electron micrographs are ... displayed on the screen 3.”).

13. As for **Claim 7**, Boles discloses, as stated in paragraph 40, wherein the display device (1) transmits the electronic tag information read by the electronic tag reader to a server and displays an image based on a response from the server (Boles states, “These previously obtained electron micrographs are retrieved by computer I ... by accessing a remote archive 140 (FIG. 4--discussed in more detail below) using a communications link 5.” To obtain images from a remote archive 140 relating to the tag 7, the electronic information relating to the tag must be transmitted to the remote archive 140 to look-up the correct image information.).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boles (US 2005/0103840 A1) in view of Lane et al. (US 7,333,001 B2).

16. As for **Claim 2**, as indicated above, Boles states, “These previously obtained electron micrographs are retrieved by computer 1 either directly from the associated RFID tag 7 using the reader/writer 6 or by accessing a remote archive 140 (FIG. 4--discussed in more detail below) using a communications link 5 ... [these] are displayed on the screen 3 and compared (e.g. visually) with electron micrographs acquired from corresponding view points from the gem stone 12 or other valuable as presented for evaluation.” Boles additionally states, “A communications link 5 links the computer with its hard drive to an archive retrieval system 140 (e.g. a server) which hosts an image and information database 110 ... this database includes fields for the identifier (# symbol 1 to # symbol n), images (I1, I2. . . In) and transactions (T1, T2 . . . Tn) such that inputting the identifier of a gem stone or other valuable enables the corresponding sets of images and transactions to be retrieved by computer 1.”

However, Boles doesn't clearly specify where the computer (1; see figure 1) further includes a decision unit which determines whether a writing of the image is permitted, and wherein the writing device writes the image into the electronic tag when the decision unit determines that a writing of the image is permitted.

On the other hand, Lane et al. also disclose an apparatus for reading/writing from/to an electronic tag attached to an article. More specifically, Lane et al. show, in figure 1, a system comprising a computer (40), a database (12), an RFID tag (4), and an RFID reader (10). Lane et al. show, in figure 2, details of the RFID tag (4). Finally, in figures 3, 7, and 8, Lane et al. show

granting reading/writing permission to the RRID reader (10) to read/write from/to the RFID tag (4). In this regard, Lane et al. state, "An RFID communications device or 'reader' 10 is used to read and/or write data from the RFID tag 4 ... [the] transmitted data may be information used to (1) validate or authenticate data, (2) validate or authenticate an identity of a conduit, source, or destination of transmitted data, (3) or to authenticate or validate permission or authorization to read from and/or write onto the RFID tag 4" (see column 15, lines 12 – 18). Moreover, in column 15 (lines 40 – 47), column 16 (lines 36 – 50), and column 21 (line 50) - column 22 (line 5), Lane et al. clearly teach where the system includes a decision unit which determines whether a writing of *data* is permitted, and wherein the writing device writes the *data* into the electronic tag when the decision unit determines that a writing of the *data* is permitted. Finally, Lane et al. state, "The present invention covers an optional ability to validate that a life event document is authentic and/or validate that all of some of the data contained in a life event document or record is accurate" (see column 9, lines 19 – 21). In other words, Lane et al. provide the advantage that data regarding an article that the electronic tag is attached to is accurate.

Thus, the Examiner submits at the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included a decision unit which determines whether a writing of *data* is permitted, and wherein the writing device writes the *data* into the electronic tag when the decision unit determines that a writing of the *data* is permitted, as taught by Lane et al., in the image pickup apparatus disclosed by Boles.

17. As for **Claim 3**, Lane et al. further teach, as shown in figures 7 and 8, wherein the decision unit transmits the electronic tag information read by the electronic tag reader to a server

and makes a determination based on a response from the server (also see column 21, line 50 – column 22, line 5).

Cited Prior Art

18. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure for the following reasons:

- **Lee (US 2004/0080530 A1)** discloses wardrobe previewing system that utilizes a portable communication camera device and electronic tags attached tot articles of clothing.
- **Valleriano et al. (US 7,327,383 B2)** discloses utilizes RFID tags to track objects and captures images of the tracked objects during an event.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lin Ye can be reached on 571.272.7372. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Justin P. Misleh/

Examiner, Art Unit 2622

May 29, 2008